

Notice of Allowability

Application No.

10/826,094

Examiner

Robert B. Mondesi

Applicant(s)

MADHYASTHA, SRINIVASA

Art Unit

1653

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to Amendmendment filed February 17, 2006.
2. ☒ The allowed claim(s) is/are 1-3, 5-7, 10-12, 15-17, 20 and 24-33.
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some* c) ☐ None of the:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
- (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
- 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
- (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statements (PTO-1449 or PTO/SB/08), Paper No./Mail Date _____
- ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Interview Summary (PTO-413), Paper No./Mail Date _____
- ☒ Examiner's Amendment/Comment
- ☐ Examiner's Statement of Reasons for Allowance
- ☐ Other _____

EXAMINER'S AMENDMENT

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it **MUST** be submitted no later than the payment of the issue fee.

Claims 1-3, 5-8, 10-12 and 15 directed to an allowable product. Pursuant to the procedures set forth in MPEP § 821.04(B), **claims 16-17, 19-20 and 24-33**, directed to the process of making or using an allowable product, previously withdrawn from consideration as a result of a restriction requirement, **claims 16-17, 19-20 and 24-33** hereby rejoined and fully examined for patentability under 37 CFR 1.104.

Because all claims previously withdrawn from consideration under 37 CFR 1.142 have been rejoined, the restriction requirement as set forth in the Office action mailed on December 13, 2004 is hereby withdrawn. In view of the withdrawal of the restriction requirement as to the rejoined inventions, applicant(s) are advised that if any claims including all the limitations of an allowable product claim or rejoined process claim are presented in a continuation or divisional application, such claims may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Once the restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. See *In re Ziegler*, 443 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

Priority

The current application filed on April 14, 2004 claims priority to provisional application 60/558,132 filed on April 1, 2004. (See, amendment to the specification filed April 14, 2006 and ADS filed April 14, 2006)

Authorization for this examiner's amendment was given in a telephone interview with Mr. Brian R. Dorn on April 6, 2006.

The application has been amended as follows:

Claim 1 (Currently amended) A composition for inhibiting bacterial biofilms on devices comprising an N-Substituted maleimide and a cationic polypeptide, wherein the cationic polypeptide is protamine sulfate.

Claim 8 (Canceled).

Claim 16 (Currently amended) A method for preparing a device comprising ~~treating~~ coating at least one surface of the device, with the composition of claim 1.

Claim 19 (Canceled).

Claim 20 (Currently amended) The method of claim ~~49~~ 17, wherein the composition comprises an effective amount of N,N'-(1,2-phenylene) dimaleimide or N-(1-pyrenyl) maleimide and protamine sulfate.

Claim 31 (Currently amended) The method of claim 16 wherein the device is selected from the group consisting of pipes, heat exchangers and computer chips.

Conclusion

Claims 1-3, 5-7, 10-12, 15-17, 20 and 24-33 are allowed.

REASONS FOR ALLOWANCE

The following is an examiner's statement of reasons for allowance: **1-3, 5-7, 10-12, 15** of the present invention are drawn to a product comprising a composition for inhibiting bacterial biofilm which is free of prior art. **Claims 16-17, 20 and 24-33** are drawn to a process of using the said composition and include all the limitations of the allowed product.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

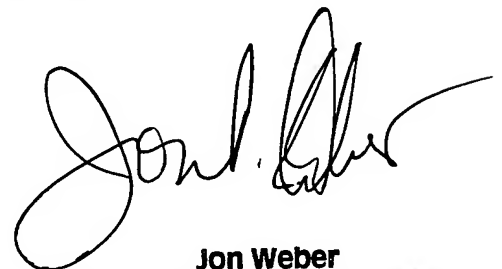
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert B. Mondesi whose telephone number is 571-272-0956. The examiner can normally be reached on 9am-5pm, Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jon Weber can be reached on 571-272-0925. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Robert B. Mondesi

Robert B. Mondesi
4-19-06



Jon Weber
Supervisory Patent Examiner